

Appl. No. 10/613,374  
Information Disclosure Statement Pursuant  
to 37 C.F.R. § 1.97(c)(2) dated October 6, 2004  
Appendix A

# Appendix A



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/139,786	05/05/2002	James C. Stevens	DOW-31628-A	4810
29423	7590	12/08/2003		
WHYTE HIRSCHBOECK DUDEK S.C. 555 EAST WELLS STREET SUITE 1900 MILWAUKEE, WI 53202				
			EXAMINER CHOI, LING SIU	
			ART UNIT 1713	PAPER NUMBER

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/139,786	Applicant(s) STEVENS ET AL.	
	Examiner Ling-Siu Choi	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 1-122 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,19,21 and 26-122 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3,4,6-18,20 and 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. This Office Action is in response to the Remarks filed September 12, 2003. Claims 97-122 have been added and claims 1, 3, 4, 6-18, 20, 22-25 of Group I were elected. In view of the Remark, Group VII, VIII, XI, and 97-122 will be rejoined with Group I if Group I is found allowable.

#### ***Claim Rejections***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:


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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*Claim Rejections - 35 USC § 102*

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Imuta et al. (US 5,504,172).

The present invention relates to a

	at least about 60 wt % of units derived from <b>propylene</b>
	at least about 0.1 wt% of units derived from <b>ethylene</b>
<sup>13</sup> C NMR peaks have about equal intensity at about 14.6 and about 15.7 ppm, which correspond to a <b>regio-error</b>	

(summary of claim 1)

Imuta et al. disclose a propylene polymer having a proportion of inversely inserted units based on the 2,1-insertion of a propylene monomer in all propylene insertions as measured by <sup>13</sup>C NMR being 0.7 to 2.0 % , wherein the propylene polymer is a polymer comprises propylene unit and less than 0.5 mol % of a unit derived from ethylene (col. 25, lines 42-46; col. 41, lines 14, 53; col. 42, line 25; claim 1). Thus, the present claim is anticipated by the disclosure of Imuta et al..

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5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Cozewith et al. (US 2002/0004575 A1).

Cozewith et al. disclose a propylene/ethylene copolymer comprising 75 to 95 wt% of propylene-derived units and 5 to 25 wt% of ethylene-derived units, wherein the copolymer has a proportion of inversely inserted propylene units based on 2,1-insertion of propylene monomer in all propylene insertions of greater than 0.5% as measured by  $^{13}\text{C}$  NMR ([0025]; claim 1).

***Claim Rejections - 35 USC § 102/103***

6. Claims 1, 3, 4, 6-18, 20, 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timmers et al. (US 5,972,822).

Timmers et al. disclose an ethylene/propylene copolymer obtained by the contact of propylene (95 psi) with ethylene (20 psi) in the presence of rac-[1,2-ethanediylbis(1-indenyl)]zirconium (trans, trans-1,4-diphenylbutadiene) and  $\text{B}(\text{C}_6\text{F}_5)_3$  on silica (Example 45). However, Timmers et al. are silent on the specific properties claimed in the present claims. In view of the copolymers prepared by using the substantial catalysts for the present invention and the disclosure of Timmers et al., the Examiner has a reasonable base to believe that the copolymer disclosed by Timmers et al. would possess the claimed specific properties because the properties

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of a polymer are mainly attributed to the catalyst system used to prepared it. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

7. Claims 1, 3, 4, 6-18, 20, 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Devore et al. (US 5,556,928).

Devore et al. disclose an ethylene/propylene copolymer obtained by the contact of 80 g propylene with 450 psig ethylene in the presence of (tert-butylamido)(tertramethyl- $\eta^5$ -cyclopentadienyl) dimethylsilane titanium (s-trans- $\eta^4$ -1,4-trans, trans-diphenyl-1,3-butadiene),  $B(C_6F_5)_3$ , and MMAO (Example 28). However, Devore et al. are silent on the specific properties claimed in the present claims. In view of the copolymers prepared by using the substantial catalysts for the present invention and the disclosure of Devore et al., the Examiner has a reasonable base to believe that the copolymer disclosed by Devore et al. would possess the claimed specific properties because the properties of a polymer are mainly attributed to the catalyst system used to prepared it. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980).

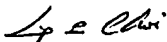
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***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is (703)305-0887.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on (703)308-2450.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-2351.



Ling-Siu Choi

November 27, 2003